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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,468	01/21/2004	Francis M. Chapman	42631-193434	1401
26694	7590	11/01/2005		
VENABLE LLP P.O. BOX 34385 WASHINGTON, DC 20045-9998			EXAMINER DOAN, ROBYN KIEU	
			ART UNIT 3732	PAPER NUMBER

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

T.A.M.

Office Action Summary

Application No. 10/760,468	Applicant(s) CHAPMAN, FRANCIS M.	
Examiner Robyn Doan	Art Unit 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/21/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 6-11, 13, 16-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Pettey (U.S. Pat. # 2,633,139).

With regard to claims 1 and 11, Pettey discloses a press-on nail device (figs. 1 and 3) comprising a plurality of thin elements (12, 13, 14), each having a thickness (col. 6, lines 5-8) and an area and shape approximating the area and shape of a nail, being made of plastic sheet material and conformable to a nail (col. 5, lines 1-3). The elements having opposite sides (fig. 3), one side with an adhesive (18) of a strength to firmly hold the element to a nail but enabling it to be peeled away from the nail when desired. In regard to claims 3, 6, 13, Pettey discloses each element being made of a polyvinyl chloride film (col. 10, lines 25-27). It is noted that the term “cast” in claim 6 is directed to a method of making the film, therefore, it is not given patentable weight in an article claim. In regard to claims 8 and 17, Pettey shows the shape of each of the thin elements having rectilinear parallel lateral edges and curving end edges (fig. 2). In regard to claims 7 and 16, Pettey shows each of the thin elements being trimmed when

each being adhered to a nail (col. 9, lines 60-66). It is also noted that limitations "the thin element is trimmable with an emery board" in claims 7 and 16 is not given patentable weight in the article claim because it directed to a method of trimming the thin element. In regard to claims 9-10 and 18-20, Pettey also discloses the adhesive adheres to a nail upon contact with the nail (col. 10, lines 32-33) and a release backing (10) in contact with the adhesive of the plurality of the thin elements and the thin element with the adhesive being peelable from the backing (col. 5, lines 24-30) and also the adhesive of the plurality of thin elements being in contact with the same release backing (col. 5, lines 24-26).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 5, 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pettey.

With regard to claims 4-5 and 14-15, Pettey discloses a press-on nail device comprising all the claimed limitations in claims 1 and 11 as discussed above except for the thickness of each element in a range of 1.5 mils to approximately 2.5 mils. It would have been obvious to one having an ordinary skill in the art at the time the invention

was made to construct the thickness of each element in a range of 1.5 mils to approximately 2.5 mils since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Claims 2 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pettey.

With regard to claims 2 and 12, Pettey discloses a press-on nail device comprising all the claimed limitations in claims 1 and 11 as discussed above and further discloses each of the elements having a color (col. 10, line 27) on the same side as the adhesive; Pettey does not disclose the color with high-gloss finish being on the opposite side of the adhesive. It would have been obvious to one having an ordinary skill in the art at the time the invention was made to place the color on the opposite side of the adhesive, since it has been held that rearranging location of parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70. And It would have been an obvious matter of design choice to a person of ordinary skill in the art to include the high-gloss finish onto the color because Applicant has not disclosed that providing the color with high-gloss finish provides an advantage, is used for a particular purpose, or solves a stated problem. Therefore, it would have been prima facie obvious to modify Pettey to obtain the invention as specified in claims 2 and 12 because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Pettey.

Claims 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pettey.

With regard to claims 21-22, Pettey discloses a press-on nail device comprising all the claimed limitations in claims 11 and 20 as discussed above and including some of the thin elements (11) having different areas from another (13, 14), the areas of each of the nails of a human hand being approximated by at least two of the thin elements (11). It is noted that the size of the nail of a human finger varies, therefore it is held that it would be obvious to have a nail of a human finger being approximated by at least two thin elements (11) as shown in figure 1.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pettey in view of Belden (U.S. Pat. # 2,288,386).

With regard to claim 23, Pettey discloses a press-on nail device comprising all the claimed limitations in claim 11 as discussed above except for a plurality of release backings, a plurality of thin elements on one of the release backings having different color or design from another plurality of thin elements of another one of the release backings. Belden discloses a press-on nail kit (fig. 7) comprising a plurality of release backings (10), each being in adhesive contact with a plurality of thin elements (11, fig. 7). It would have been obvious to one having an ordinary skill in the art at the time the invention was made to employ the plurality of release backings as taught by Belden into the press-on nail device of Pettey for the purpose of manufacturing a large quantity of

press-on nail devices. And It would have been obvious to one having an ordinary skill in the art at the time the invention was made to include different color or design of one of the plurality of thin elements, since such a modification would have involved a mere change in the color of the non critical component. A change in color is generally recognized as being within the level or ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

Claims 24, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pettey in view of Le (U.S. Pat. # 6,797,261).

With regard to claims 24, 26, Pettey discloses a press-on nail device comprising all the claimed limitations in claim 11 as discussed above except for an emery board or an orange stick. Le discloses a method of applying fingernail polish comprising an emery board and an orange stick (col. 3, lines 60-63). It would have been obvious to one having an ordinary skill in the art at the time the invention was made to employ the emery board and the orange stick as taught by Le into the press-on nail device of Pettey as a kit for the purpose of filing and cleaning the fingernail prior to a nail treatment process.

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pettey in view of Mitchell (U.S. Pat. # 6,189,539).

With regard to claim 25, Pettey discloses a press-on nail device comprising all the claimed limitations in claim 11 as discussed above except for at least one alcohol

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wipe. Mitchell discloses nail polish clean-up sticks (figs4-5) comprising at least one alcohol wipe (14, col. 3, line 62). It would have been obvious to one having an ordinary skill in the art at the time the invention was made to employ the alcohol wipe as taught by Mitchell into the press-on nail device of Pettey as a kit for the purpose of cleaning the fingernails.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bogoslowsky, Straub and Ferraro are cited to show the state of the art with respect to a press-on nail device.

The drawings filed 01/21/2004 have been approved by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robyn Doan whose telephone number is (571) 272-4711. The examiner can normally be reached on Mon-Fri 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Robyn Doan', with a long horizontal flourish extending to the right.

Robyn Doan
Examiner
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